REMARKS

In the Final Office Action mailed August 19, 2005, the Examiner rejected claims 1-11, 14-17, and 22-25 under 35 U.S.C. § 101 as being directed to non-statutory subject matter and rejected claims 1-25 under 35 U.S.C. § 102(e) as being unpatentable over *Mui et al.* (U.S. Patent Application Publication No. 2003/0229529).

By this amendment, Applicants propose to amend claims 1, 3, 5, 7, 8, 11, 12, 14-20, and 22-25, and add new claims 26-28. In light of these amendments and the following arguments, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 101 and § 102(e). Applicants note that the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants do not automatically subscribe to any statement or characterization in the Office Action.

I. The rejection of claims 1-11, 14-17, and 22-25 under 35 U.S.C. § 101

According to the Examiner, claims 1-11, 14-17, and 22-25 are "not embodied within the technological arts" and would not "result in a practical application producing a concrete, useful, and tangible result." (OA at 2). Although Applicants disagree with the Examiner's position, Applicants propose to amend claims 1, 8, and 22. Accordingly, Applicants submit claims 1-11, 14-17, and 22-25 are directed towards statutory subject matter, and thus respectfully request the rejection of these claims under 35 U.S.C. § 101 be withdrawn.

II. The rejection of claims 1-25 under 35 U.S.C. § 102(e)

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim at issue must be found, either

expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131. Finally, "[t]he elements must be arranged as required by the claim." *Id.*

The Examiner continues to assert *Mui et al.* discloses a "community of practice." (OA at 4 and 12.) In particular, the Examiner asserts the "employees" referenced by *Mui et al.* suggest the existence of an expert. The Examiner, however, points to no portion of *Mui et al.* that states an expert is included in the group of "employees." Neither does *Mui et al.* disclose an expert. It appears the Examiner is taking the position that *Mui et al.* suggests an expert. This position, however, is not proper to support an allegation of anticipation under 35 U.S.C. § 102. Instead, the cited art (i.e., *Mui et al.*) must teach each and every recitation. In this instance, the Examiner infers *Mui et al.* does not disclose an expert, but rather suggests one is included in the "employees." Accordingly, for at least this reason, *Mui et al.* does not support the rejection of claim 1 under 35 U.S.C. § 102(e), and thus should be withdrawn and the claim allowed.

Further, the Examiner asserts paragraphs 0082-0112 of *Mui et al.* teach identifying roles and responsibilities for participants of, and one or more goals for, a "community of practice." (OA at 12.) These paragraphs, however, merely refer to software objects that reflect services used by the SABA system to allow a user to perform certain software-related functions. This disclosure of software tools does not teach identifying roles and responsibilities for participants of a community of practice or one or more goals for the community of practice. Instead, the core services disclosed in

paragraphs 0082-0112 merely represent "common business services" that may be used by users of the SABA system. (*Mui et al.* at [0082].)

The Examiner also refers to paragraph 0170 and states "[i]f one is developing goals for users, it follows axiomatically that such goals are related to the participants and therefore to a community of practice." (OA at 12-13.) As best Applicants understand, the Examiner appears to argue that *Mui et al.* enables goals to be formed for users, and therefore are related to a community of practice. This conclusion is flawed. Even if *Mui et al.* discloses developing goals for users, this does not by itself teach goals for a community of practice. An individual user goal may be different from other group goals. As such, *Mui et al.* does not infer a community of practice goal by the suggestion that the reference discloses developing user goals.

Additionally, *Mui et al.* does not teach or suggest a plurality of participants in the community of practice that use a knowledge management system to exchange information to achieve the identified one or more goals, as recited in claim 1. Nowhere does the reference disclose participants using a management system to achieve a goal of a community of service. Instead, *Mui et al.* discloses a system that determines persons that are qualified to achieve a determined goal based on their competency levels. (*Mui et al.* at [0008].) In another embodiment, *Mui et al.* describes a system where competency information associated with persons is evaluated to determine whether they need additional training. (*Mui et al.* at [0009].) The system disclosed by *Mui et al.*, however, does not enable participants in a community of practice to exchange information to achieve a community of practice goal, as recited in claim 1.

Because *Mui et al.* does not support the rejection of claim 1 under 35 U.S.C. § 102(e), Applicants request that the rejection be withdrawn and the claim allowed.

Claims 2-7 depend from claim 1. As explained, *Mui et al.* does not teach the recitations of claim 1. Accordingly, the reference also fails to teach the recitations of claims 2-7 for at least the same reasons set forth in connection with claim 1. As such, Applicants respectfully request that the Examiner withdraw the rejection of claims 2-7 under 35 U.S.C. 102(e) and allow the claims.

Further, *Mui et al.* does not teach capturing knowledge from community of practice participants, as asserted by the Examiner. (OA at 5.) Contrary to the Examiner's assertions, delivering query results and the match agents disclosed by *Mui et al.* have nothing to do with capturing knowledge from community of practice participants, as recited in claim 8. Instead, the cited portions of *Mui et al.*, and any other portion, do not disclose receiving information from any type of person, much less participants in a community of practice. For instance, *Mui et al.* states in paragraph 0993 (cited by the Examiner),

> In an exemplary embodiment of the invention, referring again to FIG. 13, IDK defines interfaces for metadata generation (Importers or Import Agents 1300) and matching (Resolvers or Match Agents 1302) and for delivering query results (Dispatchers or Delivery Agents 1304). Combinations of these three services allow the Information Distributor to interoperate with a variety of enterprise systems and to service queries in a broad range of application domains.

Further, in paragraph 1002, also cited by the Examiner, *Mui et al.* states,

> Match Agents are responsible for matching between information resources and user profiles. Match Agents execute at regular intervals or in response to specific requests. They perform intelligent comparisons between

> metadata descriptions of imported resources and user profiles. These comparisons return a set of information resources as the match result.

Applicants find no hint in the above citations that show collecting knowledge from any type of individual. Indeed, *Mui et al.* does not teach such features in any portion of its disclosure. Similarly, the reference also fails to teach or suggest approving the captured knowledge, as recited in claim 8. Contrary to the Examiner's assertions, the match agents disclosed by *Mui et al.* have no correlation to approving collected knowledge, as recited in claim 8. Instead, the match agents are merely software that analyze user profiles "identifying those resources most relevant to a user's job, interests, or objectives." (*Mui et al.* at [1003].) There is absolutely no teaching or suggestion in *Mui et al.*, especially in paragraphs 1002-1003 cited by the Examiner, that show approving collected knowledge. Indeed, *Mui et al.* does not show approving any type of knowledge.

Additionally, *Mui et al.* does not teach or even suggest delivering the approved knowledge to community of practice participants over the computer network, as recited in claim 8. The Examiner again relies on paragraphs 1002-1003 to support the rejection of this claim. This reliance is improper as it is clear, these, or any other, paragraphs disclosed by *Mui et al.* do not provide any hint or suggestion of delivering approved knowledge to any individuals, much less participants of a community of practice, as recited in claim 8. Instead, *Mui et al.* states its match agents may "deliver suggestions for classes covering that technology" (i.e., technology required for a new job assignment). (*Mui et al.* at [1003].) This has no correlation to delivering approved knowledge.

Along similar lines, *Mui et al.* does not teach maintaining the knowledge in a database, as recited in claim 8. The Examiner refers to Fig. 5 of *Mui et al.* for support of the assertions set forth in the Office Action. (OA at 5.) This figure, however, merely shows components, albeit a database, of the SABA system disclosed by *Mui et al.* Merely referencing a database is not sufficient to meet the *prima facie* requirements under 35 U.S.C. § 102(e) invoked by the Examiner to reject claim 8. Fig. 5, or any other portion of *Mui et al.*, does not teach or suggest maintaining knowledge in a database, where the knowledge is collected from participants of a community of practice, as recited in claim 8.

As explained, *Mui et al.* does not teach community of practice participants including users, one or more community of practice managers, and one or more experts associated with the community of practice. Accordingly, the reference does not teach at least capturing knowledge from community of practice participants and delivering to these participants approved knowledge. Because *Mui et al.* does not support the rejection of claim 8 under 35 U.S.C. § 102(e), Applicants request that the rejection be withdrawn and the claim allowed.

Claims 9-17 depend from claim 8. As explained, *Mui et al.* does not teach the recitations of claim 8. Accordingly, the reference also fails to teach the recitations of claims 9-17 for at least the same reasons set forth in connection with claim 8. Further, *Mui et al.* does not teach the recitations of dependent claims 9-17. For example, contrary to the Examiner's assertions, the AccountabilityManager disclosed by *Mui et al.* does not manage organization membership within the context of a community of practice. (*See Mui et al.*, ¶ [0116].) Instead, the organization membership mentioned in

Mui et al. refers to organizations associated with entities in the system. Moreover, the AccountabilityManager (or any other component taught by *Mui et al.*) does not suggest or disclose accepting subscriptions for membership in the community of practice.

In addressing the above arguments regarding claims 9-17, the Examiner argues that "[c]laims 9-17 do not cite a limitation of "manage organization membership within the context of community of practice." (OA at 13.) The Examiner appears to concentrate on Applicants' reference to terms used by *Mui et al.* in alleging the cited reference teaches the recitations of these claims. (*See Mui et al.* at [0116].) The Examiner, however, neglects the very next sentence of the same quoted argument, which explains the differences between the recitations of, for example, claim 10, and *Mui et al.* That is, *Mui et al.* does not disclose or suggest advertising the community of practice or accepting subscriptions for membership in the community of practice, as recited in claim 10.

Claim 18 includes recitations similar to claim 1. For instance, claim 18 recites a community of practice including a knowledge management architecture, a plurality of users, one or more experts, and one or more community of practice managers. Further, claim 18 recites a network interconnecting the knowledge management architecture, the plurality of users, the one or more experts, and the one or more community of practice managers. Also, claim 18 recites, wherein the participants use the knowledge management architecture to exchange information to achieve a goal associated with the community of practice. Contrary to the Examiner's assertions, *Mui et al.* does not disclose these features. As explained above in connection with claim 1, *Mui et al.* does not teach a community of practice including users, experts and practice managers.

Instead, *Mui et al.* discloses persons that may be identified to perform tasks for achieving a goal. These persons and any group formed from them, do not include the community of practice managers, as recited in claim 18. Further, as explained, *Mui et al.* does not disclose a knowledge management system that allows participants to exchange information to achieve a goal associated with the community of practice. Accordingly, *Mui et al.* does not support the rejection of claim 18 under 35 U.S.C. § 102(e), and Applicants request that the rejection be withdrawn and the claim allowed.

Claims 19-21 depend from claim 18. As explained, *Mui et al.* does not teach the recitations of claim 18. Accordingly, the reference also fails to teach the recitations of claims 19-21 for at least the same reasons set forth in connection with claim 18. As such, Applicants respectfully request that the Examiner withdraw the rejection of claims 19-21 under 35 U.S.C. 102(e) and allow the claims.

Additionally, *Mui et al.* does not teach at least identifying a community or practice manager and one or more experts for the community of practice, as recited in claim 22. As explained above, the persons that perform tasks in *Mui et al.* do not include practice managers. Instead, a manager of the organization uses the software applications to determine how a goal can be achieved using members of an already established team. The manager may not even be part of that team and is not identified as part of a community of practice including users and experts.

The Examiner is misplaced in asserting "experts being the identified session managers" described in paragraphs 0083-0112 of *Mui et al.* (OA at 15.) The session

managers are software executed by computer components and not, as the Examiner alleges, experts or any type of individual.

Further, as explained above in connection with claim 1, *Mui et al.* does not teach managing, by the computer system, the community of practice by allowing participants in the community of practice to exchange information to achieve a goal associated with the community of practice. As such, *Mui et al.* does not teach the recitations of claim 22, as asserted by the Examiner. Therefore, Applicants request that the rejection of claim 22 under 35 U.S.C. § 102(e), be withdrawn and the claim allowed.

Claims 23-25 depend from claim 22. As explained, *Mui et al.* does not teach the recitations of claim 22. Accordingly, the reference also fails to teach the recitations of claims 23-25 for at least the same reasons set forth in connection with claim 22. As such, Applicants respectfully request that the Examiner withdraw the rejection of claims 23-25 under 35 U.S.C. 102(e) and allow the claims.

III. New Claims 26-28

Mui et al. does not teach or suggest the recitations of new claims 26-28, and thus Applicants request the timely allowance of these claims.

IV. Conclusion

Applicants respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-28 in condition for allowance. Applicants submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in

the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 9, 2005

By: _____
Joseph E. Palys
Reg. No. 46,508